

USSN 09/337,584

### **REMARKS**

Claims 42, 43, 45-53, and 57-58 were pending for examination prior to this amendment. Claim 42 has been amended to add the limitations of former claim 43 and to reword the language referring to the length of the nucleic acid molecule. Claim 43 has been canceled. New claims 59 and 60 have been added. New claim 59 includes the limitations of claim 42 and claim 45, without the limitation to a palindrome. Claims 42, 45-53, and 57-60 are pending for examination with claims 42 and 59 being independent claims. No new matter has been added.

### **Information Disclosure Statement**

Applicant encloses herewith an information disclosure statement and form 1449 for consideration by the examiner. The form 1449 includes a listing of references that have come to Applicant's attention as well as papers from currently pending Interference No. 105,171. The Applicant of the above-identified patent application is also named as an inventor on an issued patent US Patent No. 6,207,646 B1 which is currently involved in Interference No. 105,171. The above-identified patent application derives priority from US 6,207,646 B1. In view of the priority Applicants have included on the attached 1449 a listing of all of the motions filed in the Interference to date, as well as references exchanged by the parties. Copies are enclosed for the Examiner's review. If the examiner would like any additional information on this subject she is encouraged to contact Applicants' representative at the number listed below.

### **Rejection under 35 USC 102**

Claims 42, 48-53, and 57 have been rejected under 35 USC 102(e) as being anticipated by Carson et al (5,849,719).

Claims 42, 48-53, and 57 are novel in view of Carson et al., because each of the claims includes a limitation on the length of the nucleic acid. The claimed nucleic acid may not be longer than 100 nucleotides. It is asserted that the claims do not limit the length of the immunostimulatory nucleic acid. Applicant disagrees. An immunostimulatory nucleic acid that

USSN 09/337,584

has “between only” 8 and 100 nucleotides in length is an oligonucleotide of a defined length. The claim does not state that the nucleic acid “comprises” a nucleic acid 8-100 nucleotides in length. The claim recites a nucleic acid that has *only* 8 to 100 nucleotides in length. Such a claim cannot be interpreted to cover nucleic acids longer than 100 nucleotides in length. The specification is consistent with this interpretation of the claims. For instance, support for the limitation that the immunostimulatory nucleic acid is 8-100 nucleotides in length is found on page 14 lines 25-26 and page 19 lines 4-5 of US Serial No. 08/738,652 (now, issued as US Patent No. 6,207,646) from which the above-identified patent application derives priority and which is incorporated by reference. The use of a size limitation in the specification always refers to a molecule of restricted, defined length. Additionally claim 52 recites the limitation that “the immunostimulatory nucleic acid is 8 to 40 nucleotides in length.” The only possible interpretation of this language is that the nucleic acid has a length of 8-40 nucleotides and no longer.

In order to expedite prosecution, Applicant has amended the claims to move the limitation relating to length and to replace the word “has between only” with the word “of”. The claims now recite a nucleic acid of 8 - 100 nucleotides in length. The nucleic acids may not be longer or shorter than the prescribed length limitation of 8-100 nucleotides.

USSN 09/337,584

**CONCLUSION**

If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Helen C. Lockhart", written over a horizontal line.

Helen C. Lockhart, Reg. No. 39,248  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, MA 02210-2211  
(617) 646.8000

Docket No. C1039.70022US00

Date: September 30, 2004